

REMARKS/ARGUMENTS

The Office Action contained rejections of the claims under 35 USC §§102 and 103. Each will be responded to below.

a. Response to §102 Rejections

Claims 1-6, 10 and 11 were rejected under 35 USC §102(b) as being anticipated by *Sacre* (US 4,776,109). Claims 1-5 were rejected under 35 USC §102(b) as being anticipated by *Lin* (US 4,619,056). For the reasons explained below, Applicant respectfully traverses both rejections.

Applicant's claim 1, from which claims 2-11 depend, expressly requires that the insert is formed of a substantially non-compressible material, and that (a) the upper layer of material in the arch portion has a thickness generally similar to that of the material in other areas, and (b) the downwardly extending ribs prevent the upper layer of material from collapsing and changing shape under the foot.

Sacre and *Lin* fail to show these elements. Neither reference discloses that the upper layer in the arch area has a thickness generally the same as the remainder of the body: *Sacre* states that different areas of the material are in fact thicker and thinner (e.g., column 2, lines 60-66); *Lin* in turn, appears to be silent on the thicknesses of the material in different areas of the body.

Moreover, in both *Sacre* and *Lin*, the ribs function to cause the upper layer of the device to collapse and change shape under the foot: *Sacre* expressly states that the ribs enable the upper layer (30) to "flex up and down when a person lifts and lowers his or her foot while walking or running", thereby developing a pumping action. *Lin*, in turn, discloses a soft device in which the ridges collapse so as to allow the upper surface to compress downwardly under the foot (e.g., column 2, lines 60-66), in order to produce a "cushioning" effect. In both instances, this is directly opposite what is required by Applicant's claims, i.e., that the ribs prevent the upper layer of material from collapsing and changing shape under the foot.

In order to anticipate a claim, the reference must teach every element of the claim (MPEP 2131). For the reasons explained above, neither *Sacre* nor *Lin* teach (a) an orthotic insert having a cutout area such that the upper layer of molded material in the arch portion has a thickness that is generally similar to the thickness of the material in other areas, or (b) a plurality of ribs that support the upper layer of material so as to prevent it from collapsing and changing shape under the foot. Applicant therefore respectfully requests that the rejections of the claims under 35 USC §102 be reconsidered and withdrawn.

b. Response to §103 Rejections

Claims 1-11 were rejected under 35 USC §103(a) over *Brown* (US 5,722,186) in view of *Lin* or *Sacre*. In support of the rejection, the Examiner asserted "*Brown* shows an insert...substantially as claimed except for ribs located under the raised arch portion. Either *Lin* or *Sacre* teaches providing ribs (20 or 40) beneath a raised arch portion of an insert. It would have been obvious to provide ribs as taught by either *Lin* or *Sacre* in the arch portion of the insert of *Brown* to increase support and ventilation." Applicant respectfully traverses this rejection as well.

In order to establish a *prima facie* case of obviousness, all of the claim limitations must be taught or suggested (MPEP 2141). As explained above, *Sacre* and *Lin* show neither (a) an upper layer of material, over a cutout below the arch portion, having a thickness that is generally similar to the thickness of material in other areas, nor (b) ribs that support the arch area and prevent the upper layer of material from collapsing and changing shape under the foot. *Brown* '186 adds nothing that would teach or suggest such limitations. The arch portion of the *Brown* '186 device is flexible and is spaced above the insole of the shoe, so that (as is the case with *Sacre* and *Lin*) the upper layer collapses and changes shape under the foot (e.g., column 10, lines 14-27). Modifying *Brown* '186 to have the ventilating/pumping rib structure of *Sacre* or the cushioning rib structure of *Lin* would not meet to the requirements of Applicant's claims, since in resulting structure the upper layer would still collapse downwardly under the weight of the foot. Moreover, if one were to provide the arch area of the *Brown* '186 device with a rib structure that did in fact prevent the upper layer from collapsing downwardly under the foot, this would defeat

the intended purpose of *Brown* '186, i.e., that this area of the device flex up and down under the foot as the person walks; a proposed modification that would render the prior art device unsatisfactory for its intended purpose cannot support a *prima facie* case of obviousness (MPEP 2143.01).

In order to establish a *prima facie* case of obviousness, the prior art references must teach or suggest all the claim limitations (MPEP 2143). For the reasons explained above, *Brown* '186, *Sacre* and *Lin*, taken alone or in combination, fail to teach or suggest all of the limitations of Applicant's claim 1 and its dependent claims. Applicant therefore respectfully submits that a *prima facie* case of obviousness has not been established, and requests that the rejection of the claims under 35 USC §103 be reconsidered and withdrawn.

c. Conclusion

Applicant respectfully requests reconsideration of the present application in view of the amendments and remarks set forth herein. It is believed that the claims are now in condition for allowance. If there is any matter that can be expedited by consultation with Applicant's attorney, such would be welcome. Applicant's attorney can normally be reached at the telephone number given below.

Signed at Bellingham, County of Whatcom, State of Washington this 2nd day of May 2005.

Respectfully submitted,

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